

filed
Aug. 10, 1979

IN THE
Supreme Court of the United States
OCTOBER TERM, 1979

No. . . . **79 - 223**

REID C. GOODBAR and ARTHUR M. PRESSLEY,
Junior Party Patentees,

Petitioners,

vs.

DONALD W. BANNER, Commissioner of Patents
and Trademarks,

MARVIN A. CHAMPION, NORMAN G. TORCHIN, and
MICHAEL SOFOCLEOUS, Members U.S. Patent and
Trademark Office Board of Patent Interference,

and

WILLIAM KLEIN, Senior Party Applicant,

Respondents.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS**

JOSEPH J. C. RANALLI
330 Madison Avenue
New York, New York 10017
Counsel for all Petitioners

Of Counsel

JOSEPH J. CATANZARO
FREDERICK F. CALVETTI

PENNIE & EDMONDS
330 Madison Avenue
New York, New York 10017
Attorneys for all Petitioners

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Petitioners respectfully pray that a Writ Of Certiorari issue to review the order of the United States Court of Customs and Patent Appeals entered in this proceeding on May 31, 1979.

Decision Below

The decision of the United States Court of Customs and Patent Appeals was reported as *Goodbar v. Banner*, — F.2d —, 202 USPQ 106 (CCPA 1979) and appears in the Appendix.

Jurisdiction

The decision of the United States Court of Customs and Patent Appeals was rendered on May 31, 1979. This Petition For Writ Of Certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 USC 1256. *Brenner v. Manson*, 383 U.S. 519 (1966).

Question Presented

Whether the United States Court of Customs and Patent Appeals (CCPA) erred in holding that it is without jurisdiction to entertain a Petition For Writ Of Mandamus to vacate a discovery order issued by the U.S. Patent and Trademark Office Board of Patent Interferences (board) because the discovery order might not result in evidence related to the issue of priority or to an ancillary issue involving priority?

Statement of the Case

The Petition For Writ Of Mandamus derived from United States Patent Interference No. 98,935. On March 6, 1975, the U.S. Patent and Trademark Office (PTO) declared an interference between Reid C. Goodbar and Arthur M. Pressley (Goodbar), junior party patentees,¹ and William

¹ U. S. patent No. 3,703,073 issued to Goodbar on November 21, 1972 based on application serial No. 63,755, filed August 14, 1970.

G. Klein (Klein), senior party applicant.²

The junior party in an interference is the first to present evidence on the issue of priority, i.e., evidence that the junior party was the first to conceive the invention and the first to reduce it to practice. Goodbar presented evidence of his conception and reduction to practice during his testimony-in-chief and the senior party, Klein, during cross-examination, made certain discovery requests under 37 CFR 1.287(b). That section provides:

(b) The provisions of paragraph (a) of this section are without prejudice to the right of a party, *where appropriate*, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony. [Emphasis added.]

Goodbar refused Klein's requests on the grounds that those requests were inappropriate. On July 18, 1978, Klein filed a Motion For Production of Documents under 37 CFR 1.287(c). That section provides:

(c) Upon motion (§ 1.246)³ brought by a party during the period for preparation for testimony, or thereafter as authorized under § 1.246, and upon *a showing that the interest of justice so requires*, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of

² U. S. application serial No. 262,108 was filed by William G. Klein on June 12, 1972 and is a division of application serial No. 29,822 filed April 4, 1970, which matured into U. S. patent No. 3,678,675.

³ 37 CFR 1.246 provides:

A motion or other paper belatedly filed will not normally be considered except upon *a showing, under oath or in the form of a declaration (§ 1.68)*, of sufficient cause as to why such motion or paper was not timely presented.

Civil Procedure, specifying the terms and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority. [Emphasis added.]

Klein's motion contained twenty-two (22) requests for production of documents. The board denied all but three (3) of Klein's requests. Because Goodbar responded to one request and is prepared to respond to another, only one request was in issue. Goodbar petitioned to the Commissioner of Patents and Trademarks (Commissioner) to reverse the decision of the board granting discovery on the remaining request.

Goodbar maintained that the board abused its discretion. Goodbar's principle objection was that the board had improperly provided discovery of documents which are privileged and/or proprietary without just cause or proper safeguards.

After offering an interpretation of the board's decision, the Commissioner affirmed the board's order. However, that interpretation did not obviate Goodbar's principal objection to the board's decision. Consequently, Goodbar petitioned the CCPA for issuance of a Writ Of Mandamus pursuant to 28 USC 1651(a) of the All Writs Act, 28 USC 1542(1), 35 USC 141 and CCPA Rule 7.1.

Goodbar urged that the CCPA had jurisdiction to entertain his petition based on that Court's specific holding in *Cook v. Dann, Comm'r of Pats.*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975). Although the CCPA denied Cook's Petition For Writ Of Mandamus on the merits of his petition, the CCPA specifically held that it had the authority to issue a Writ of Mandamus to review a decision by the board under 37 CFR 1.287(c) prior to a determination of priority.

On May 31, 1979, Goodbar's petition was, nevertheless, dismissed on the ground that the CCPA was without power to entertain the Petition For A Writ Of Mandamus "since the matter complained of is not one which would be cognizable before this court on appeal from a decision of the board awarding priority. [A8]"

The CCPA's *ratio descedendi* centers on the following, — F.2d at —, 202 USPQ at 109:

The language relied upon here by petitioners was not intended to convey the meaning they wish to ascribe to it. In *Cook*, the court stated "The Patent [and] Trademark Office (PTO) respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. § 1651(a)) must be rejected." 522 F.2d at 1276, 188 USPQ at 176. We were there responding to a suggestion by the Commissioner in the PTO brief that "As previously submitted in the commissioner's opposition to the petition in *Duffy v. Tegtmeier* [citation], the court lacks jurisdiction to issue an order in the nature of mandamus on the commissioner in a patent case." (Emphasis ours.)

Thus, while it may not be clear from the face of the court's opinion in *Cook*, we did not there intend to imply that this court had jurisdiction over the action complained of by Cook. We were there dealing with this court's basic power to act under the All Writs Act in attempting to correct the erroneous interpretation of the law by the PTO to the effect that this court could never issue a writ of mandamus to the Commissioner in a patent case. As to the merits in *Cook*, we were of the opinion that, assuming subject matter jurisdiction to be present, we could not find an abuse of discretion on the part of the PTO. In *Cook* we did not decide whether we had jurisdiction. [A6-A7] [Insertions and emphasis in original.]

Reasons for Granting the Writ

The CCPA candidly admitted that the "recent proliferation of petitions for extraordinary relief" is the reason for it to "once more . . . analyze the jurisdictional basis which empowers us to grant such relief [A7]."

Goodbar submits that the CCPA should not be permitted *sua sponte* to limit its jurisdiction as a means of alleviating its case load particularly where the self-imposed limitation prevents it from fulfilling its duties as an appellate court.

Goodbar asserted that the board had improperly provided discovery of documents which contain privileged and/or proprietary information. This is the very type of situation where appellate courts have not hesitated to invoke their jurisdiction by way of mandamus because it is well recognized that once the information is improperly exposed the privileged and proprietary nature of that information is lost forever. This Court's review, therefore, is necessary to safeguard these important rights and privileges.

A further reason for the Court to grant the writ is that a conflict presently exists between the CCPA and the Second Circuit Court of Appeals regarding the extent of the CCPA's jurisdiction in discovery matters under 37 CFR 1.287(c). Guidance from this Court is necessary if uniformity among the courts is to be obtained.

I

In Denying Jurisdiction, The CCPA Committed Error Which Will Seriously Erode Long Standing Legal Principles.

Courts have issued writs of mandamus under circumstances similar to those involved here to prevent dissemination of privileged and confidential information.

Diversified Industries, Inc. v. Meredith, 572 F.2d 596 (8th Cir. 1977); *U.S. Board of Parole v. Merhige*, 487 F.2d 25 (4th Cir. 1973), cert. denied, 417 U.S. 918 (1974); *Harper & Row Publishers, Inc. v. Decker*, 423 F.2d 487 (7th Cir. 1970), aff'd 400 U.S. 348 (1970); *U.S. v. Hemphill*, 369 F.2d 539 (4th Cir. 1966).

The CCPA in *Cochran v. Kresock*, 530 F.2d 385, 396, 188 USPQ 553, 561 (CCPA 1976) recognized the principle that proprietary information should be guarded and also set forth the standard for review under 37 CFR 1.287(c) involving such information:

Paragraph (c) of Rule 287 states that the additional discovery provided by the paragraph *may* be granted by the board. It is therefore clear that the discovery sought by appellant is not a matter of right, but rather is discretionary with the board. We do not ordinarily interfere in matters which are discretionary within the Patent and Trademark Office *unless there has been a clear showing of abuse of that discretion*. *Cook v. Dann, Comm'r of Pats.*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975). [Emphasis in original.]

Thus, the CCPA recognized the importance of safeguarding this type of information from improper dissemination. Nevertheless, it now states that it is without jurisdiction to entertain a writ of mandamus seeking to do just that.

The CCPA's statements in *Cochran*, its reliance therein on *Cook* and the fact that the petition in *Cook* was denied rather than dismissed* demonstrate that the CCPA's failure

* The CCPA explained the significance between the terms "denied" and "dismissed", — F.2d at —, 202 USPQ at 109:

Even in cases where the writ does not issue, there is a significant difference between dismissing a petition for lack of jurisdiction and denying a petition for want of a good cause on the merits. [A7].

to find jurisdiction is little more than a method to reduce "the recent proliferation of petitions." This Court should therefore grant this petition and issue a Writ of Certiorari so that the significant issues raised in the Petition For Writ Of Mandamus may be given a proper review.

II

There Is A Clear And Substantial Conflict Between The Second Circuit And The CCPA Regarding PTO Discovery Rule 37 CFR 1.287(c).

The CCPA based its decision on the fact that review of the board's order would not be ancillary to priority and consequently would not be subject to review on appeal to the CCPA from a final decision of the board awarding priority of invention. The CCPA does, however, have the power to review the board's discovery decision on appeal. 37 CFR 1.287(c) specifically provides for such a review. The rule states, in pertinent part:

An order by the Board *granting or denying* a motion under this paragraph shall not be subject to review *prior to a decision awarding priority*. [Emphasis added.]

The Second Circuit recently reviewed this rule in *Shattuck v. Hoegl*, 555 F.2d 1118, 194 USPQ 405 (2nd Cir. 1977). The matter there under review was a decision of the District Court for the Northern District of New York in connection with an ancillary PTO interference discovery proceeding instituted under 35 USC 24. Judge Meskill writing for the Court stated, 555 F.2d at 1121, 194 USPQ at 408:

A party in the position of IBM is not left without a remedy. The Patent Office has recently adopted a rule [37 CFR 1.287] under which discovery may be conducted in interference proceedings. Moreover, a party

disappointed by an interference proceeding has access to two Article III courts. *An appeal may be taken to the Court of Customs and Patent Appeals.* If that court finds that discovery against a party should have been ordered, it can vacate the decision of the Patent Office . . . Inasmuch as the chosen forum for review may be able to remedy any error in the discovery proceedings there is no reason to allow this interlocutory appeal. [Footnotes omitted; emphasis added.]

Even though *Shattuck* involved an interlocutory appeal, that fact does not distinguish that authority here. Simply, the Second Circuit has recognized that matters involving discovery before the board are reviewable by the CCPA and that the CCPA can remedy errors in such proceedings. The CCPA, in holding that it lacks jurisdiction to review discovery matters either by way of mandamus or appeal, disregards the Second Circuit's holding in *Shattuck*.

As a consequence of the decision below, petitioners are obliged to turn over what may well be critical, privileged documents as well as substantial proprietary information to a competitor without review of any court even after priority has been determined. What is more anomalous is that the CCPA is able to conclude that the subject matter sought to be discovered does not involve a question of priority and is not ancillary to priority while prefacing this conclusion by saying that "it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence. [Emphasis in original.]" (A7).

Goodbar submits this Court should grant this petition to resolve this anomalous situation so that uniformity among courts will exist regarding discovery proceedings under 37 CFR 1.287(c).

CONCLUSION

For the reasons presented, this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

JOSEPH J. C. RANALLI
Counsel for all Petitioners

Of Counsel

JOSEPH J. CATANZARO
FREDERICK F. CALVETTI
PENNIE & EDMONDS
330 Madison Avenue
New York, New York 10017
Attorneys for all Petitioners

APPENDIX**Decision of the Court of Customs and Patent Appeals.****UNITED STATES COURT OF CUSTOMS AND
PATENT APPEALS**

Appeal No. 79-555.

On Petition for Writ of Mandamus

Interference No. 98,935.

REID C. GOODBAR and ARTHUR M. PRESLEY,
Junior Party Patentees,
Petitioners,

v.

DONALD W. BANNER, Commissioner of
Patents and Trademarks,

MARVIN A. CHAMPION, NORMAN G. TORCHIN, and MICHAEL
SOFOCLEOUS, Members U. S. Patent and Trademark Office
Board of Patent Interference, and

WILLIAM KLEIN, Senior Party Applicant,
Respondents.

DECIDED: May 31, 1979

Before MARKEY, Chief Judge, RICH, BALDWIN, LANE,* and
MILLER, Associate Judges.

RICH, Judge.

* Judge Lane took part in the consideration and decision of
this matter but died before the decision was announced.

*Appendix—Decision of the Court of Customs
and Patent Appeals.*

Petitioners seek a writ of mandamus, directing the Patent and Trademark Office (PTO) Board of Patent Interferences (board) to vacate its order compelling petitioners to produce for inspection and copying certain documents in connection with interference No. 98,935. Respondents are the Commissioner of Patents and Trademarks (Commissioner), the board, and Klein, petitioners' interference adversary. Oppositions to the petition have been filed by the Commissioner and Klein.

This petition was kindled by testimony elicited from Dr. Roger Varin, former Director of Research for Riegel Textile Corporation, assignee of the junior party petitioners' patent. This testimony was taken during the junior party petitioners' testimony-in-chief period. Specifically, on cross-examination, Dr. Varin testified that he kept a file of correspondence generated while he was employed by Riegel. After testifying that he was familiar with the contents of the file, the following was elicited:

- Q. Did you find anything relating to this proceeding?
A. There were some things.

As a result of this testimony, respondent Klein filed a MOTION FOR PRODUCTION OF DOCUMENTS UNDER 37 CFR 1.287 (b) and (c) requesting, inter alia, the production of Dr. Varin's correspondence file for inspection and copying.

Petitioners opposed production of the file. They asserted that the request was overly broad and indefinite and would require the production of documents containing confidential and proprietary information. They also stated that Klein has failed to show that production of the file would be in the "interests of justice" as required by 37 CFR 1.287(c).

The board granted respondent Klein's motion, but only to the extent that the documents to be produced were the

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and Patent Appeals.*

ones referred to in Dr. Varin's testimony as being related to this proceeding. The board stated:

With regard to requests 2, 4 and 5 [request 5 is the only one at issue here], the motion is granted as being in the "interest of justice". As to request 2, there is no ostensible objection. As to requests 4 and 5, the motion paper indicates that Klein ascertained the probable existence of the photographs [the subject of request 4] and the "somethings" [sic, some things] during cross-examination and their existence could not have been determined earlier by inspecting the documents served under § 1.287(a). *Also request 5 is considered properly limited to the subject matter of the counts in issue inasmuch as it is limited to "somethings" [sic, some things] related to this proceeding.* [Emphasis ours.]

The board adhered to this decision on reconsideration.

Relief was requested from the Commissioner by a petition to reverse the decision of the board. Commissioner Banner denied the petition with the following comments:

Petitioners maintain that the board should have denied request 5 because the documents sought thereby were not limited in scope to a relevant time period. It is apparent that petitioners have misinterpreted the board's order. *A fair reading of the board's order, taken in light of the motion and opposition before the board and Dr. Varin's cross-examination, demonstrates that the board only ordered petitioners to make discovery of the "some things" in his file which relate "to this proceeding," or as respondent's counsel put it those things which "relate to this subject matter."*

Since the board's order properly limits the documents, both as to scope of time and subject matter, it follows

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and Patent Appeals.*

that the board correctly ruled on respondent's request 5. [Emphasis ours.] Accordingly, the decision of the board granting request 5 is affirmed [emphasis in original].

Petitioners assert an abuse of discretion on the part of the board in granting the request, and on the part of the Commissioner in refusing to reverse the board's decision. They claim, as they did before the board, that the request is overly broad and indefinite, and that the material sought to be discovered is proprietary and confidential. We are asked to issue mandamus to vacate the decision of the board and its order requiring the production of documents as per request 5.

Petitioners have also, by motion, requested oral argument on their PETITION FOR MANDAMUS. Respondent Klein opposes the motion.

OPINION

1. *Request for Oral Argument*

The motion for oral argument is denied. Oral arguments on petitions for extraordinary relief are not granted unless directed by this court. See CCPA Rule 7.1(b). The court does not find oral argument helpful in cases such as this where the issues are clear and the case is not complex. Cf. *United States v. Watson, Judge, United States Customs Court and Michelin Tire Co.*, Appeal No. 79-17, argued May 2, 1979 (oral argument granted on Government's motion due to complexity and importance of issues).

2. *The Requested Writ*

Under 28 USC 1651(a), the All Writs Act, this court, as one "established by Act of Congress," has the power to issue all writs "necessary or appropriate in aid of [our]

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and Patent Appeals.*

jurisdiction" (emphasis ours). *Loshbough v. Allen*, 56 CCPA 913, 404 F.2d 1400, 160 USPQ 204 (1969). The All Writs Act is not an independent grant of appellate jurisdiction, and, therefore, the appellate jurisdiction which the writs are "in aid of" must have some other basis. *Roche v. Evaporated Milk Assoc.*, 319 U.S. 21, 23-26 (1943). This basis, of course, must be found within the *subject matter jurisdiction* of this court, since the All Writs Act does not bestow upon this court the power to adjudicate issues falling outside of this jurisdiction. The crucial question is thus whether we have subject matter jurisdiction over the issues presented in the petition for extraordinary relief. For this reason, it is incumbent upon any petitioner seeking such relief in this court to demonstrate that we have subject matter jurisdiction over the issue involved.

The present petition arises out of an interference. Specifically, it is the result of a decision of the board which granted the senior party's request for additional discovery, made by motion under 37 CFR 1.287(b) and (c). Since there is no appeal from decisions of the board on motions, any support for the jurisdiction of this court must be found elsewhere.¹

¹ We, like all other federal appellate courts, are bound by the final judgment rule which limits our jurisdiction to final decisions of the PTO appeal boards, as contrasted with decisions which are merely interlocutory. See *Feigelman v. Meyers*, 476 F.2d 1475, 177 USPQ 530 (CCPA 1973); *United States Treasury v. Synthetic Plastics Co.*, 52 CCPA 967, 341 F.2d 157, 144 USPQ 429 (1965); *Seamless Rubber Co. v. Ethicon, Inc.*, 46 CCPA 950, 268 F.2d 231, 122 USPQ 391 (1959). While certain exceptions to this rule exist in order to further the interests of justice and judicial economy, see e.g., *Stabilisierungsfonds Fur Wein v. Zimmermann-Graeff KG*, 198 USPQ 154 (CCPA 1978); *Toro Co. v. Hardigg Industries Inc.*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*, 59 CCPA 1300, 467 F.2d 501, 175 USPQ 417 (1972), we find no reason to extend the exception to the case at bar.

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This court has appellate jurisdiction over interferences by virtue of 28 USC 1542 and 35 USC 141. The latter section limits our jurisdiction to issues involving "the question of priority," which question includes matters ancillary to priority. *Duffy v. Tegtmeier*, 489 F.2d 745, 180 USPQ 317 (CCPA 1974). Thus, we have no jurisdiction to entertain this petition unless it can be said to involve a matter ancillary to priority over which we would have appellate jurisdiction in the normal course of events on appeal from a decision of the board awarding priority. As shown below, this appeal does not involve such a matter.

In support of their position, petitioners rely on *Cook v. Dann*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975), in which this court rejected a challenge to its jurisdiction under the All Writs Act. In that case, Cook sought a writ of mandamus to direct the board to vacate its decision limiting the scope of discovery in an interference, an issue quite similar to that which we are now confronting. According to petitioners here, "this court held in *Cook v. Dann*, Comm'r of Patents [citation] that it had the authority to issue a writ of mandamus to review a decision by the PTO under 37 CFR 1.287 prior to a determination of priority."

We do not read *Cook* so broadly. The language relied upon here by petitioners was not intended to convey the meaning they wish to ascribe to it. In *Cook*, the court stated "The Patent [and] Trademark Office (PTO) respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. § 1651(a)) must be rejected." 522 F. 2d at 1276, 188 USPQ at 176. We were there responding to a suggestion by the Commissioner in the PTO brief that "As previously submitted in the commissioner's opposition to the petition in *Duffy v. Tegtmeier* [citation], the court lacks jurisdiction to issue an order in the nature of

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mandamus on the commissioner in a patent case." (Emphasis ours.)

Thus, while it may not be clear from the face of the court's opinion in *Cook*, we did not there intend to imply that this court had jurisdiction over the action complained of by Cook. We were there dealing with this court's basic power to act under the All Writs Act in attempting to correct the erroneous interpretation of the law by the PTO to the effect that this court could *never* issue a writ of mandamus to the Commissioner in a patent case. As to the merits in *Cook*, we were of the opinion that, assuming subject matter jurisdiction to be present, we could not find an abuse of discretion on the part of the PTO. In *Cook* we did not decide whether we had jurisdiction.

The recent proliferation of petitions for extraordinary relief has caused us once more to analyze the jurisdictional basis which empowers us to grant such relief. It cannot be assumed that subject matter jurisdiction is present in every case. Even in cases where the writ does not issue, there is a significant difference between dismissing a petition for lack of jurisdiction and denying a petition for want of a good case on the merits.

In the case before us, the action complained of by petitioner would not be subject to review by this court on appeal after a determination of priority by the board. This matter relates to the scope of discovery; a witness has testified that he has certain material relevant to the interference proceeding. The opposing party seeks this material. At this stage of the proceeding, it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence. This is certainly not a question of priority, and we are of the opinion that it is not ancillary to priority as the case law has developed the meaning of that term. The happenstance that the ordered discovery *might* result in evidence bearing

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and Patent Appeals.*

upon or even establishing priority does not make this issue ancillary to priority.²

We therefore hold that we are without power to entertain *this* petition for a writ of mandamus since the matter complained of is not one which would be cognizable before this court on appeal from a decision of the board awarding priority.

The petition is *dismissed*. The motion for oral argument is *denied*.

² In contrast, the question of whether evidence was properly admitted, as well as questions regarding the weight to be accorded evidence, have been held to be ancillary to priority, and, hence, reviewable by this court after a determination and award of priority. *Piel v. Falkner*, 57 CCPA 1132, 426 F.2d 412, 165 USPQ 708 (1970).